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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,071	09/26/2003	Matthias Meinicke	H01.2-11313	9288

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VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/673,071

Applicant(s)

MEINICKE ET AL.

Examiner

Brian R. Gordon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-16-07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 17-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-16 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a gripping tool, classified in class 422, subclass 63.
 - II. Claims 17-25, drawn to a dosage tool, classified in class 422, subclass 100.
 - III. Claims 26-35 are, drawn to a tool support for an automatic laboratory machine, classified in class 422, subclass 99.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I II, and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination of the gripping tool has separate utility such as transferring vials or other containers from one location to another location. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to

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provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Richard Arrett on April 20, 2007 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-35 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 15, 16, and 36. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

9. Claims 1-16 are objected to because of the following informalities: Reference number 49 is referred to a coupling appliance. The claims are not consistent with the specification. Reference numeral 79 is disclosed as the coupling appliance and 49 is the driving feature. Appropriate correction is required.

It should be noted the while reference numbers are allowed in the claims. The numbers are not considered as a substitute for positively claiming specific elements. For

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example, while numbers 9 and 10 are cited in claim 1, it is not required that the prior art disclose a gripping appliance in the form of "gripping levers" as defined in the specification by the numbers. Such a requirement is only required in the examination of claim 2.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 15, 16, and 36. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1 it is unclear what the pronouns "them" and "it" are directed as recited in lines 4 and 7, respectively.

It should be noted the power take-off and drive appliance (78) of tool support (66) of the automatic laboratory machine is not an element of the invention. The claim is drafted in a manner which those unclaimed element(s) are mentioned in terms how the claimed elements are intended to be used therewith.

4. Claim 10 recites the limitation "the threaded nut" in the last line. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 12 recites the limitation "the appliance for indicating" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 6-8 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Le Comte et al. US 6,818,182.

Le Comte et al. discloses a laboratory blood processing device that includes multiple pickup mechanisms (gripping tools). can be seen more particularly in FIG. 5, each of the pick-up mechanisms 32 comprises two clamping assemblies 114 each

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having two jaws 116 and is arranged to pivot about a pin 118. Each clamping assembly defines a cam groove 120 of a chosen configuration which is designed to work in conjunction with a cam finger 121. The device here includes four cam fingers 121 carried by the pins 122 on an H-bracket 124 mounted at the end 126 of a rod 128, itself mounted at the end of the sleeve 95.

Also, the two jaws of the same clamp are drawn together by the action of a resilient return spring 130 allowing the jaws to adapt to the different diameters of the tubes used. The rod 128 is capable of sliding axially and with a linear movement into an aperture 129 in the disk 110, whilst its end 126 is capable of sliding into an aperture 134 in the mobile head. The rod 128 incorporates two flats 131 one of which bears against a base 135 on the mobile head 100, enabling the rod 128 and the head 100 to be locked and rotated or released according to their mutual axial position.

Thus, when the rod 128 is caused to move axially relative to the mobile head 100, it opens and closes the respective jaws 116 of the two pick-up mechanisms.

The motor 88 is actuated in the screw-in direction and the nut 94 is brought up against the shaft 90 of the motor 88, and the locking means 132 and 133 are placed in the unlocked position, rotation of the motor in the screw-in direction allows the mobile head 100 to be rotated, when the latter is retracted away from the cassette.

Claim Rejections - 35 USC § 102

8. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hubert et al., US 6,589,789.

Hurbert et al. disclose a robotic centrifuge loading device. The dual function tool has a tube 20 gripper and an adapter gripper 22 on separate vertical axis. When one gripper is made operational it is lowered and the other gripper is raised to an inactive position; when one is up, the other is always down. Gripping/releasing controls are built into each gripper and each set of controls acts independently.

The preferred tube gripper is a two-finger device with a mandrel 26 positioned between and above the cavity scribed by the two fingers 24. This mandrel is used to sense tube height. The tube gripper is moved to a position where the fingers are on either side of the tube and the mandrel is above the tube and projecting into the cavity scribed by the fingers. The tool then lowers gripper, the mandrel touches the top of the tube and is moved vertically. Sensors (not shown) on the mandrel interface with sensors on its housing to detect a tube that is either too tall, is within a defined acceptable range, or is too short. Using sensors, the robot notes whether the tube is long or short, then picks up the tube and places it into an available position in "empty adaptor A". By removing a tube, an empty puck is created at the interface gate. By noting whether the tube is 'long' or short, the station controller keeps track of the estimated weight of 'adaptor A' and its mate, 'adaptor B'. The gripper sensors can also close on a tube to determine if the tube is 13 mm or 16 mm, which further refines the weight estimate.

The open/close state of the gripper must be established by gripper sensors.

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The following things can be monitored in manual mode from the manual mode screen: the robot position on all axes in physical units the state of all I/O bits the gripper sensor bits: jam detect, full open, full close, close to 13 mm, close to 16 mm.

The equivalent structures of the claimed elements the prior are clearly illustrated in figures 2B and 3A.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hubert et al.

Hubert et al. does not specify how the position sensors are connected to the device.

However screw and nut connections are conventional and well known in the art.

It would have been obvious to one of ordinary skill in the art to recognize the sensors may be connected to the device by employing various means including a screw and nut configuration.

Allowable Subject Matter

12. Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose needles and liners direct towards each other.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Testrut, Dietmar et al.; Kittock, Mark J. et al.; Wernz, Martin et al.; Pang; Wing S. et al.; Wernz; Martin et al.; Mayer; William J.; Friswell; David R. et al.; Bybee; Thomas L. et al.; Hamel; Marc et al.; Carney; Christopher F. et al.; Scatizzi; Mario; Lewis; Edmund T. et al.; Schinzel; Fred; Newberg; Douglas A. et al.; van der Plaats; Gosse et al.; Syska; Peter et al.; Iles; Kenneth E.; Clark; Frederick L. et al.; Hardie; Robert et al.; Aota; Kensaku et al.; Lang; Karl; Polk, Jr.; Lewis T. et al.; Shaw; James D.; and Feiber; Wolfgang E. A. et al. disclose various grippers, jaws, clamping, and lever devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, Telework Thurs., 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brian R Gordon
Primary Examiner
Art Unit 1743

brg

BRIAN R. GORDON
PRIMARY EXAMINER